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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/791,447	03/02/2004	Janzen Lo	BBM-147US	3444
23122	7590	08/07/2007		
RATNERPRESTIA			EXAMINER	
P O BOX 980			HOFFMAN, MARY C	
VALLEY FORGE, PA 19482-0980				
			ART UNIT	PAPER NUMBER
			3733	
			MAIL DATE	DELIVERY MODE
			08/07/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/791,447

Applicant(s)

LO ET AL.

Examiner

Mary Hoffman

Art Unit

3733

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 May 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) 6-19 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02 March 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

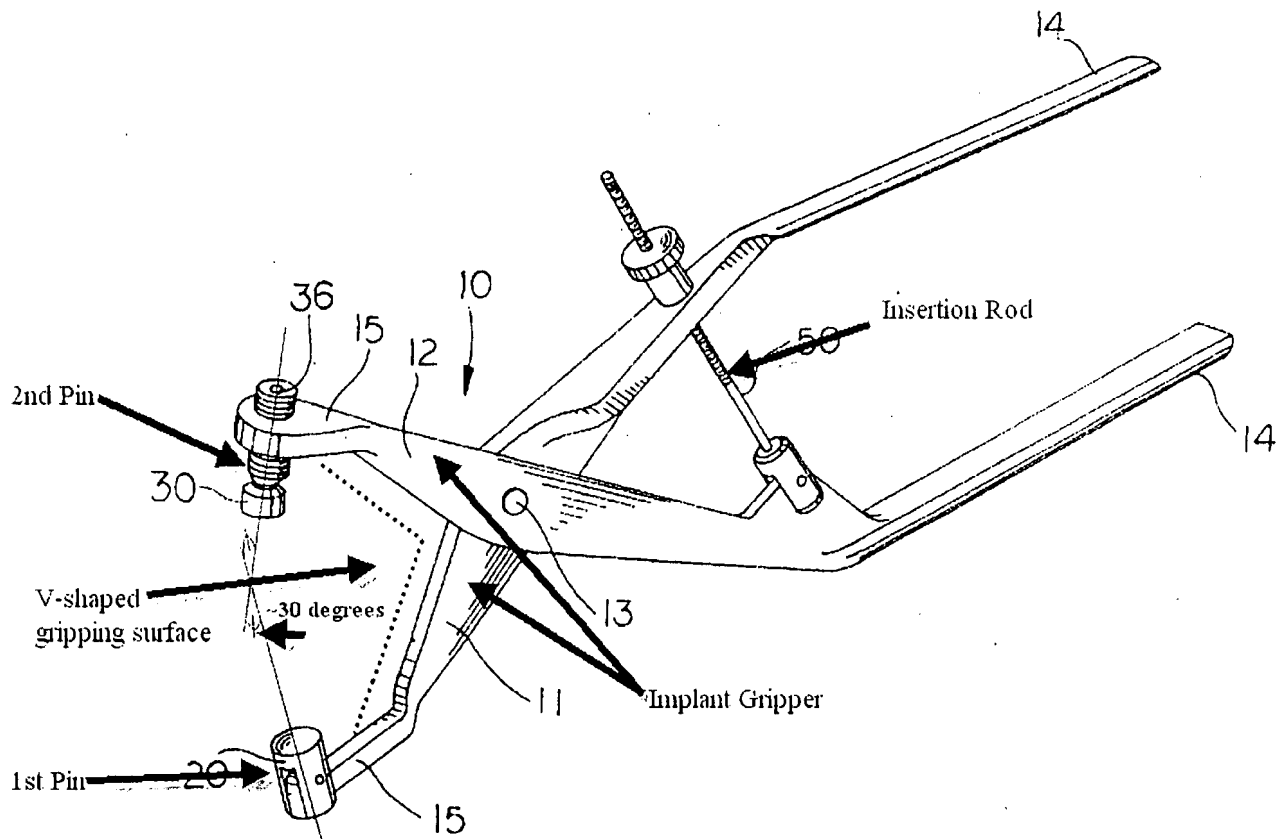
The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1- 5 are rejected under 35 U.S.C. 102(b) as being anticipated by Lane (U.S. Patent No. 5,735,857).

Lane discloses an implant insertion device comprising an insertion rod (ref. #50) and an implant gripper (ref. #11,12,15) attached to the insertion rod, the implant gripper including a v-shaped gripping surface (see marked-up figure below); a first pin (ref. #20) extending from and fixed relative to the gripping surface; and a second pin (ref. #36) extending through and movable relative to the gripping surface between a first position wherein the second pin extends from the gripping surface a distance x and a second position wherein the second pin extends a distance less than x from the gripping surface (the pin ref. #36/34 is threaded to be adjustable, i.e. movable within a hole formed in ref. #15 of arm ref. #12). The pins are offset/separated by an angle of approximately 30 degrees when the device is in the expanded/open configuration, as in the marked-up figure below, and are not parallel with each other, as shown in the below marked-up figure. The first pin is smooth and the tip (ref. #30) of the second pin (ref. #36) is smooth. The implant gripper is removable from the insertion rod (ref. #50).



Response to Arguments

Applicant's arguments filed 05/24/2007 have been fully considered but they are not persuasive. Applicant argues that the Lane reference does not disclose 1.) a v-shaped gripping surface, 2.) a second pin extending through and movable relative to the v-shaped gripping surface, and 3.) wherein the first pin and said second pin are offset on the v-shaped gripping surface.

First, regarding applicant's assertion that the Lane reference lacks a v-shaped gripping surface, the examiner respectfully disagrees and it is noted that the above marked-up figure has been provided to clearly point out what the examiner is

Art Unit: 3733

considering the gripping surface. As shown in the marked-up figure, the inner sides of elongated arms components ref. #11 and 12, and 15 (not ref. #'s 20 and 30 as suggested by Applicant) comprise the gripping surface. These inner surfaces clearly form a v-shape. While the examiner acknowledges that the Lane reference discloses that the components denoted by ref. #'s 30 and 20 directly contact the implant to make up gripping surfaces, the instrument of Lane would also be capable of gripping an implant between elongated arm components ref. #11 and 12 if an implant were placed between these two elongated arms during use. Applicant is reminded that a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. Because one is capable of using the Lane instrument to grip an implant between the elongated arm components, the Lane reference anticipates the current claims.

Second, regarding Applicant's assertion that the Lane reference lacks a second pin extending through and movable relative to the v-shaped gripping surface, the examiner respectfully disagrees. Pin ref. #34/36 is threaded and is adjustable, i.e. moveable, relative to the surface defined by ref. #'s 15 and 12 because the pin is threaded and extends through a hole at the distal end of ref. #15.

Third, regarding Applicant's assertion that the Lane reference lacks a first pin and said second pin offset on the v-shaped gripping surface, the examiner respectfully disagrees. The pins (ref. #34/36/30 and ref. #20) are clearly offset, i.e. the pins

Art Unit: 3733

counteract each other at opposite sides of the gripping surface. When the instrument is in its expanded or open position shown in FIG. 1, rather than the closed position shown in FIG. 2, the pins are offset from each other at an angle and they are not parallel to each other.

The rejections are deemed proper.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mary Hoffman whose telephone number is 571-272-5566. The examiner can normally be reached on Monday-Friday 9:00-5:00pm.

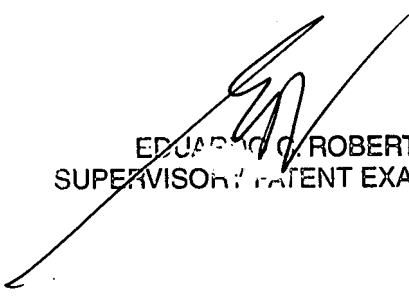
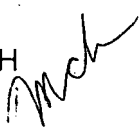
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo C. Robert can be reached on 571-272-4719. The fax phone

Art Unit: 3733

number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

MCH



EDUARDO C. ROBERT
SUPERVISORY PATENT EXAMINER